According to the Examiner, "DeGasparo et al. discloses salts of valsartan, comprising valsartan and hydroxycarboxylic acids, including citric acid" and "teaches that the pharmaceutical compositions of the invention comprise 0.1-100% active ingredient and are manufactured by conventional mixing and granulating." (Office Action at Page 4). "Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include acids in the compositions comprising valsartan, to increase the solubility of the preparation." (Office Action at Pages 4-5). The Examiner concludes that "because of the teachings of DeGasparo et al., that valsartan can be in the form of pharmaceutically acceptable salts, one of ordinary skill in the art would have a reasonable expectation that the dosage form claimed in the instant application would be successful". (Office Action at Page 5). Thus, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made. The Applicants respectfully disagree.

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Section 706.02(j) M.P.E.P. (citing *In re Vaeck*, 947 F.2d488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Applicants respectfully submit that DeGasparo discloses pharmaceutical compositions of valsartan for the treatment of diabetic nephropathy. Page 2 of this reference discloses that the valsartan can be in the form of pharmaceutically acceptable acid addition salts. These salts may be formed with an acid such as citric acid. The reference also discloses on Page 4 that the pharmaceutical compositions disclosed may be manufactured in a "manner known per se, for example, by means of conventional mixing, granulating, confectioning, dissolving or lyophilising." Formulation Example 1 on Page 6 describes the formulation of a hard gelatin capsule and indicates that several components of the formulation are granulated in water. Thus, citric acid is only used in

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this reference as a means to prepare a salt of valsartan. This salt form of the active compound is then used to make a pharmaceutical composition according to conventional methods, such as wet granulation.

In contrast, the instant invention discloses the preparation of a compressed solid dosage form of valsartan, particularly using a unique dry compression method. However, the instant specification contains similar language as DeGasparo regarding the preparation of valsartan, for example, "A pharmaceutically acceptable salt of valsartan can be prepared in a manner known per se. Thus for example, acid addition salts are obtained by treatment with an acid or a suitable ion exchange agent." (Specification at Page 4, Lines 8-10). This similarity in language regarding the preparation of valsartan is not a coincidence since, in fact, DeGasparo and the instant application are commonly owned subject matter. Indeed, while DeGasparo indicates that the compound of formula (I) and the salts thereof is described in European Patent Application No. 443,983, the instant application incorporates US Patent No. 5,399,578 for the preparation of valsartan. European Patent Application No. 443,983 and US Patent No. 5,399,578 are equivalent documents.

While both DeGasparo and the instant application recite similar methods for the preparation of pharmaceutically acceptable salts of valsartan, Applicants' use of citric acid as disclosed on Page 6 in the Specification *to facilitate accelerated release of the dosage form* is a clearly unobvious and distinguishable use of citric acid from that disclosed in DeGasparo. Citric acid is never mentioned in any way in DeGasparo other than to prepare a salt of valsartan; there is absolutely nothing in De Gasparo that motivates or teaches the use of citric acid as a pharmaceutically acceptable additive for any specific purpose, let alone to facilitate the accelerated release of the active agent as claimed by Applicants. As such, Applicants respectfully submit that contrary to the Examiner's opinion, the inclusion of acids in compositions comprising valsartan, particularly to achieve accelerated release of the active agent, is not rendered obvious by the use of citric acid described in DeGasparo. To that end, the limited disclosure in DeGasparo cannot provide a reasonable expectation that the accelerated release dosage form claimed in the instant application would be successful.

In addition, DeGasparo cannot render the instant invention prima facie obvious as it does not teach or suggest a dosage form of valsartan which "exhibits accelerated release of the active

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agent" as claimed by Applicants. Thus, as DeGasparo doesn't teach or suggest all the claim limitations, this reference cannot render Applicants' invention prima facie obvious.

Finally, the Examiner has objected to Claims 36 and 37 as they are dependent from rejected Claim 33, Claim 39 has been objected to as it is dependent from rejected Claim 38 and Claim 41 has been objected to since it is dependent from rejected Claim 40. As rejections of Claims 33, 38 and 40 should be effectively overcome by the filing of the terminal disclaimer herewith, Applicants respectfully request that Claims 36, 37, 39 and 41 be allowed as dependent claims as originally filed.

In view of the forgoing, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

If there are any fees due in connection with this communication, including any fees for a required extension of time, such an extension is requested and the Commissioner is authorized to charge the fees to Deposit Account No. 19-0134 in the name of Novartis Corporation.

Respectfully submitted,

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Date: April 26, 2002

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claim 29 has been amended as follows:

29. (Amended) The compressed solid dosage form according to claim 28 wherein the accelerated release constitutes about 90% release within a 10 minute~~, more particularly, a 5 minute~~ period.

Claim 34 has been amended as follows:

34. (Amended) The compressed solid dosage form according to claim 33 wherein the accelerated release constitutes about 90% release within a 10 minute~~, more particularly, a 5 minute~~ period.